

Remarks/Arguments

Reconsideration of the above-identified application in view of the present amendment and the following remarks is respectfully requested. By the present amendment, claims 1, 8, and 15 have been amended. Claims 5, 7, 9, and 13 have been canceled.

Claim Rejections – 35 U.S.C. §103

Claims 1-4, 6, and 8-12 were rejected under 35 U.S.C. §103(a) as being anticipated by U.S. Patent No. 5,507,800 to Strickland (hereafter “Strickland”) in view of U.S. Patent No. 2,764,814 to Jecker (hereafter “Jecker”). Claim 6 was canceled in the Response of February 3, 2009 and, thus, the rejection of claim 6 is moot.

Claims 7, 9, and 13 have been canceled by the present amendment. It is respectfully submitted that amended claim 1 is patentable over Strickland and Jecker and is therefore allowable.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Amended claim 1 recites an apparatus for cutting bone that includes a cutting blade that extends in a first plane between a shield section and a guide section that extends axially beyond the shield section. The shield section includes an inwardly facing shield surface that extends in a second plane that is transverse to the first plane. The shield surface is substantially wider in width in the second plane than the guide section. The guide section includes an enlarged substantially sphere shaped

terminal end. In other words, amended claim 1 requires that a narrower, spherical guide section extends axially beyond a wider shield section.

Strickland does not teach or suggest this structure. The Examiner acknowledges that Strickland does not teach or suggest a guide section having a substantially sphere shaped terminal end, but asserts that Jecker cures the deficiencies of Strickland. The combination of Strickland and Jecker, however, does not teach or suggest the structure recited in amended claim 1.

The Examiner is attempting to incorporate the ball shaped enlargement (h) of the tailoring tool of Jecker into the surgical tome 10 of Strickland. Strickland teaches a tome having a blade 13 recessed by a pair of blunt protuberances 17, 18. As clearly seen in Figs. 2-3, the widths of the protuberances 17, 18 in a plane transverse to the blade 13 are identical. Accordingly, if the ball shaped enlargement (h) of Jecker were incorporated into the longer protuberance 17 of Strickland, the longer protuberance 17 would have a width equal to or greater than the width of the shorter protuberance 18. In other words, the tome of Strickland, modified to incorporate the ball shaped enlargement (h) of Jecker, does not teach or suggest a narrower, spherical guide section that extends axially beyond a wider shield section.

Likewise, if the ball shaped enlargement (h) of Jecker was incorporated into the longer protuberance 58 (Figs. 10-11) or 99 (Figs. 19-20), the resultant device would not exhibit a narrower, spherical guide section that extends axially beyond a wider shield section. For these reasons, it is respectfully submitted that the proposed modification of Strickland in view of Jecker does not teach or suggest the

structure recited in amended claim 1. Accordingly, it is respectfully submitted that amended claim 1 is patentable over the combination of Strickland and Jecker and is therefore allowable.

Claims 2-4 depend from claim 1 and are allowable for at least the same reasons as claim 1 and for the specific limitations recited therein.

Amended claim 8 recites an apparatus for cutting through the cortical bone of a vertebral body that has an arcuate cutting blade extending in a first plane between a first tip portion and a second tip portion that extends axially beyond the second tip portion. The first tip portion has a shield surface that extends in a second plane that is transverse to the first plane. The second tip portion comprises a blunt tooth that has an enlarged substantially sphere shaped terminal end. The shield surface of the first tip portion is substantially wider in width in the second plane than the blunt tooth. In other words, amended claim 8 requires that a narrower, substantially sphere shaped second tip portion extends axially beyond a wider first tip portion.

As noted, the combination of Strickland and Jecker does not teach or suggest a narrower, sphere shaped first structure that extends axially beyond a wider second structure. For these reasons, the combination of Strickland and Jecker does not teach or suggest the structure recited in amended claim 8. Accordingly, it is respectfully submitted that amended claim 8 is patentable over the combination of Strickland and Jecker and is therefore allowable.

Claims 10-12 depend from claim 8 and are allowable for at least the same reasons as claim 8 and for the specific limitations recited therein.

Claims 5, 7, 13, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Strickland in view of U.S. Patent No. 117,588 to Woods (hereafter "Woods"). Claims 5 and 13 have been canceled and, thus, the rejection of claims 5 and 13 is moot. It is respectfully submitted that the combination of Strickland and Woods does not teach or suggest the structure recited in amended claim 15.

Amended claim 15 recites an apparatus for cutting bone that has a cutting blade extending in a first plane between a shield section and a guide section. The shield section includes an inwardly facing shield surface that extends in a second plane that is transverse to the first plane. The inwardly facing shield surface is substantially wider in width in the second plane than the guide section. The guide section projects axially beyond the shield section. In other words, amended claim 15 requires that a narrower shield section extends axially beyond a wider guide section.

Neither Strickland nor Woods teaches or suggests an apparatus having a shield section that is substantially wider in width in a plane transverse to a cutting blade plane than an inwardly facing shield surface of a shield section. Strickland does not teach this structure since, as noted, the protuberances of Strickland are either exactly the same width (Figs. 2-3 and 10-11) or the shorter protuberance is narrower than the longer protuberance (Figs. 19-20).

Woods does not cure the deficiencies of Strickland. Woods discloses a tool that has a guide (b) and a guard (c) for ripping seams sewed in cloth. Figs. 1-3 show that the guard is wider than the guide only along the outwardly facing lateral surface of the tool. In other words, the guard (c) is only wider than the guide (b) in a plane that is parallel, i.e., not transverse, to the plane of the cutting blade (a). On the other

hand, since the guide and the guard have the same thickness in a direction running substantially perpendicular to the blade (a) (Fig. 1), the surfaces of the guide and the guard that face inward towards the blade have the same width. For these reasons, Woods does not teach or suggest a shield section that extends axially beyond a guide section and that is narrower than the guide section in a plane that extends transversely to a cutting blade. Woods therefore does not cure the deficiencies of Strickland. Accordingly, it is respectfully submitted that amended claim 15 is patentable over the combination of Strickland and Woods and is therefore allowable.

In view of the foregoing, it is respectfully submitted that the above-identified application is in condition for allowance, and allowance of the above-identified application is respectfully requested.

Please charge any deficiency or credit any overpayment in fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

/Richard S. Wesorick/

Richard S. Wesorick
Reg. No. 40,871

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO L.L.P.
1300 East Ninth Street, Suite 1700
Cleveland, Ohio 44114
TEL: (216) 621-2234
FAX: (216) 621-4072
Customer No. 26,294